REMARKS

This communication is in response to the Office Action ("Office Action") mailed on July 31, 2002, in which Claims 1-19 were rejected. Claims 1-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,266,683 to Yehuda et al. ("Yehuda") in view of U.S. Patent No. 6,081,829 to Sidana ("Sidana"). Thus, the claims pending for reconsideration are Claims 1-19. Additionally, the Information Disclosure Statement previously submitted on June 24, 1999, was only partially considered as some references did not have accompanying dates. At this point, the applicants affirm that it is applicants' understanding that these references were publicly available at least as early as the date on which they were printed, namely March 20, 1999. Applicants also wish to thank Examiner Romero and Examiner Herndon for taking the time to discuss the Office Action and references during a telephone interview on September 5, 2002, in which it was agreed that the dates were missing from only those references that had not been previously considered from the Information Disclosure Statement of June 24, 1999. For the reasons set forth below, applicants respectfully request reconsideration and allowance of this application.

Prior to discussing the reasons why applicants believe that the claims as amended in this application are allowable, a brief discussion of the present invention, followed by a brief discussion of the cited and applied references, is presented. The following discussion of applicants' invention and the cited and applied references are not provided to define the scope or interpretation of any of the claims of this application. Instead, these discussions are provided to help the United States Patent and Trademark Office (hereinafter "the Office") better appreciate important claim distinctions discussed thereafter.

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Summary of the Invention

The present invention addresses one of the shortcomings of previous forms of providing content by providing the ability to scalably associate annotations with a vast number of content sources. Each annotation is represented by an object with a number of properties. One of those properties is a document identifier. The document identifier identifies the content source with which the annotation is associated. Accordingly, in one embodiment of the present invention a document identifier for a content source is sent to a tier I server, which provides a first response that indicates whether one or more annotations are associated with the document identifier and provides a reference to a tier II server that maintains additional information for each one of the annotations associated with the document identifier. A request is sent to the tier II server for additional information for one of the annotations associated with the content source. The tier II server provides a second response that describes one or more properties of the annotation and provides a reference to a tier III server for the annotation. An annotation identifier for the annotation which is associated with the content source, is sent to the tier III server. A third response, received from the tier III server, comprises a body for the annotation identified by the annotation identifier.

As can be seen from the above description, the present invention provides multiple tiers of servers that progressively provide more specific information about an annotation associated with a content source. It will further be appreciated by those of ordinary skill in the art and others that a tiered server computing environment is a scalable environment because each tier of servers provides minimal information. A tier I server can point to a plurality of tier II servers for more detailed information and the tier II servers in turn can point to still further tier III servers for even more information, thereby distributing both the bandwidth processing and memory loads associated with obtaining progressively more detailed information.

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Summary of the Principal References Cited

The Yehuda Reference

The Yehuda reference provides a network document management system that includes the ability for participants to comment on documents. All the documents are managed by a document management computer system. Yehuda's document management computer system centralizes storage and management of documents under consideration by the participants. Yehuda utilizes both a distribution and retrieval system where users may upload revisions and comments to the document management computer system. The revised documents and comments may then be distributed to other users. Essentially, Yehuda discloses a small scale document revision system with no accommodation or need for a scalable document system to accommodate a vast number of participants, documents, and/or comments. Yehuda does not disclose a multiple tier computing system.

The Sidana Reference

The Sidana reference provides a Web-based "reflector" system for accessing annotations and comments associated with Web pages. Sidana channels all requests for annotations via a reflector computing system that also hosts the annotation information to be associated with Web pages. This means that as the number of annotations and Web pages increases, the reflector will become a bottleneck. No provision for increased loads due to potentially vast numbers of annotations or Web pages is provided by Sidana. This is particularly clear as all the annotation information is stored on the reflector (column 10, lines 56-57). As with Yehuda, Sidana does not disclose a multiple tier computing system.

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The Claims Distinguished

Rejection of Claims 1-6 Under 35 U.S.C. § 103(a)

Claim 1 has been amended to more clearly point out and describe the present invention. Accordingly, applicants submit that the 35 U.S.C. § 103(a) rejection of Claim 1 no longer applies. Neither Yehuda nor Sidana teaches, discloses, or suggests a scalable method, let alone a scalable method using a multiple tier computing system that associates an annotation with a content source. Scalability is the ability to continue to function well as the size or volume increases to meet user demands. Neither Yehuda nor Sidana addresses scalability or the ability to function as the number of annotations and/or documents increases.

Therefore, applicants assert that Claim 1 is now in condition for allowance. Since Claims 2-6 all depend from Claim 1, Claims 2-6 are allowable for at least the reasons noted above. Claims 2-6 include additional recitations that further distinguish them from the teaching of Yehuda and Sidana.

For example, Claim 4 recites an annotation with a file type (much like an e-mail attachment). Neither Yehuda nor Sidana teaches using separate files as annotations. Rather, Yehuda and Sidana teach comments and/or annotations as simply text annotations. Accordingly, Claim 4 is allowable for this reason as well.

Claim 5 recites unique annotation-type properties. Since, as noted above, neither Yehuda nor Sidana teaches different types of annotations, clearly neither Yehuda nor Sidana teaches type-specific properties. Accordingly, Claim 5 is allowable for this reason as well.

Rejection of Claims 7-15 under 35 U.S.C. § 103(a)

As already noted above, neither Sidana nor Yehuda teaches a multiple tier computing system, let alone a scalable method for presenting annotations from a multiple tier computing system as claimed in amended Claim 7. Since neither Yehuda nor Sidana teaches, discloses, or

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suggests a scalable method using a multiple tier computing system as claimed in amended Claim 7, applicants submit that Claim 7 is in condition for allowance.

Since Claims 8-15 all depend from Claim 7, Claims 8-15 are submitted to be allowable for at least the reasons noted above. Claims 8-15 include sections that further distinguish them from Yehuda and Sidana. For example, Claim 10 recites sending a request to a tier II server and receiving a second response including a reference to a tier III server. Neither Yehuda nor Sidana teaches, discloses, or suggests a tier II server, let alone a tier III server. All Yehuda and Sidana teach or suggest is a single server system with the annotation information residing on the single server. While multiple computers may be used in either Yehuda or Sidana, there is no teaching, disclosure, or suggestion that these could be combined in a scalable fashion in either Yehuda or Sidana. For this reason as well, Claim 10 and its dependent Claims 11-15 are submitted to be allowable.

Rejection of Claims 16-19 Under 35 U.S.C. § 103(a)

Claims 16-19 correspond to method Claims 1, 3, 4 and 6 respectively and are submitted to be allowable, as amended, for at least the reasons discussed above with regard to Claims 1, 3, 4, and 6.

Combination of Yehuda and Sidana References

The Office Action states that Yehuda teaches all the elements of Claims 1-19 except "using document identifier to identify the content source." The conclusion reached in the Office Action is that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Sidana into Yehuda ... in order for the user to easily modify annotations associated with the document in a Web document processing environment." Applicants submit that this conclusion is based on an impermissible hindsight construction of the claimed invention. Yehuda is an HTML-based system. Thus, there is no need to add the

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URL-redirecting aspect of Sidana to Yehuda. Such an addition would not result in any improvement, Web based or not. Accordingly, applicants submit that there is no motivation for one of ordinary skill in the art to combine the teaching of these references.

Applicants submit that rejection of Claims 1-19 is predicated on combining prior art references that contain no teaching or suggestion of how the cited references could be combined in any manner, much less the manner recited in the rejected claims. Simply put, the cited and applied prior art taken alone or in combination simply does not teach or suggest the subject matter of Claims 1-19. The Office Action fails to point out any suggestion in the art for the desirability of the suggested modification absent the teachings of the applicants' disclosure. The rejection is using hindsight reasoning based on the present disclosure to "produce" the claimed invention. The references do not teach or suggest how they could be combined in any manner, much less the manner recited in the rejected independent Claims (1, 7 and 16). In this regard, the Examiner's attention is directed to the following Federal Circuit and C.C.P.A. decisions:

> It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law. *Orthopedic Equipment, Inc. v. United States*, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983).
>
> *******
>
> Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

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The *ACS Hospital Systems, Inc. v. Montefiore Hospital* decision has been cited with approval by the Federal Circuit. See *In re Geiger*, 2 U.S.P.Q. 2d 1276, 1278 (Fed. Cir. 1987). Similar statements have been made in many decisions of the Board of Appeals.

> Nor do we see any suggestion in either of the references which would lead anyone having ordinary skill in the art to combine the structure taught by either reference with that taught by the other.
>
> In order to justify a combination of references such as is here suggested it is necessary not only that it be physically possible to combine them, but the art should contain something to suggest the desirability of doing so. Since the art does not suggest the use of either of the patented devices for . . . there is nothing to indicate that one should be modified in view of the other for that purpose. *Ex parte Walker*, 135 U.S.P.Q. 195, 196 (Bd. App. 1962).
>
> *******
>
> We have studied the references and the manner in which the examiner proposes to combine their teachings but we are unable to find in these references any suggestion that they should or could be combined, absent appellant's disclosure in the present application. *Ex parte Lennox*, 144 U.S.P.Q. 224, 225 (Bd. App. 1964).
>
> While as an abstract proposition it might be possible to select features from the secondary references, as the examiner has done, and mechanically combine them with the Mallin device to arrive at appellant's claimed combination, we find absolutely no basis for making such combination neither disclosed nor suggested in the patents relied upon. **In our view only appellant's specification suggests any reasons for combining the features of the secondary references with the primary reference and under the provisions of 35 U.S.C. 103 that does not constitute a bar.** *Ex parte Fleischmann*, 157 U.S.P.Q. 155 (Bd. App. 1967). (Emphasis added.)
>
> *******
>
> **In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed**

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> **invention, however, is clearly directed to a combination of elements. That is to say, appellant does not claim that he has invented one or more new elements but has presented claims to a new combination of elements. To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.** *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. App. 1985). (Emphasis added.)

In summary, applicants submit that Claims 1-19 are clearly allowable in view of a lack of teaching, suggestion or modification in the cited and applied references. Furthermore, even if the references were combinable in the manner discussed in the remarks accompanying the rejection of the claims, and applicants specifically deny such combinability, the resultant combination would not meet all of the recitations of the claims, as noted above.

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CONCLUSION

In view of the foregoing remarks, applicants submit that the present application is now in condition for allowance. Reconsideration and reexamination of this application, as amended, allowance of the rejected claims and passage of the application to issue at an early date is respectfully solicited. If the Examiner has any questions or comments concerning this application, the Examiner is invited to contact the applicants' undersigned attorney at the number below.

Respectfully submitted,

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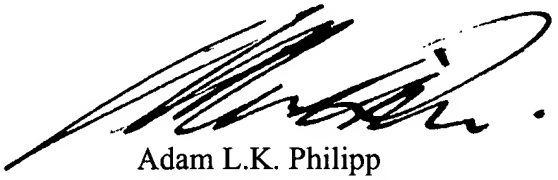

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VERSION WITH MARKINGS TO SHOW CHANGES MADE OCTOBER 31, 2002

In the Specification:

The Cross-Reference section on page 1, line 19, has been amended as follows:

CROSS-REFERENCES TO RELATED APPLICATIONS

This application is related to co-filed and co-assigned [US patent application] U.S. Patent Application No. 09/339,635, filed on June 24, 1999, entitled "Scalable Computing System for Managing Dynamic Communities," [[Attorney docket #777.21Ous1 / Client ref. #130670.1].] This application is also related to co-filed and co-assigned [US patent application] U.S. Patent Application No. 09/339,733, filed on June 24, 1999, entitled "Scalable Computing System for Managing Annotations," [[Attorney docket # 777.209us1 / Client ref. #130669.1].]

In the Claims:

Claims 1, 7, 10, and 16 have been amended as follows:

1. (Amended) A scalable method of associating an annotation with a content source, the method comprising:

representing an annotation as an object having a plurality of properties wherein one of the plurality of properties is a document identifier property; and

associating the annotation with a content source using the document identifier property wherein the document identifier property identifies the content source with which the annotation is associated, wherein the annotation is retrievable from an annotation server in a multiple tier computing system.

7. (Amended) A scalable method of presenting an annotation associated with a content source, the method comprising:

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sending a document identifier for a content source to a tier I server, said tier I server being part of a multiple tier computing system that also includes a tier II server; and

receiving a first response from the tier I server, [wherein the] said first response [comprises] comprising an indication of whether one or more annotations are associated with the document identifier and a reference to [a] said tier II server, said tier II server maintaining additional information for each one of the annotations associated with the document identifier.

10. (Amended) The method of Claim 7, wherein said multiple tier computing system also includes a tier III server and further comprising:

sending a request to the tier II server for additional information for one of the annotations associated with the content source; and

receiving a second response from the tier II server, [wherein the] said second response [comprises] comprising one or more properties for the annotation and a reference to [a] said tier III server for the annotation.

16. (Amended) A computer readable medium comprising computer executable steps for executing a scalable method for associating an annotation with a content source, the method comprising:

representing an annotation as an object having a plurality of properties wherein one of the plurality of properties is a document identifier property; and

associating the annotation with a content source using the document identifier property, [wherein the] said document identifier property [identifies] identifying the content source with which the annotation is associated, said annotation being retrievable from an annotation server in a multiple tier computing system.

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In the Abstract:

The paragraphs beginning at page 18, lines 6, 2, and 11, have been combined and amended to make one paragraph as follows:

A computing system capable of associating annotations with millions of content sources is described. An annotation is any content associated with a document space. The document space is any document identified by a document identifier. The document space provides the context for the annotation. [One aspect of the invention is a method of associating an annotation with a content source.] An annotation is represented as an object having a plurality of properties. The annotation is associated with a content source using a document identifier property. The document identifier property identifies the content source with which the annotation is associated. A scalable computing system for managing annotations responds to requests for presenting annotations to millions of documents a day. The computing system consists of multiple tiers of servers. A tier I server indicates whether there are annotations associated with a content source. A tier II server provides an index to the body of the annotations. A tier III server provides the body of the annotation. [An annotation is represented as an object having a plurality of properties. The annotation is associated with a content source using a document identifier property. The document identifier property identifies the content source with which the annotation is associated.]

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